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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,006	07/25/2000	Amir Herzberg	6727/OH449	7174

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09/09/2002

Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

ABDI, KAMBIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,006

Applicant(s)

HERZBERG ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-35 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 15, 16, 20, 27, 28, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,991,740 to Stephen Dale Messer and U.S. Patent No. 6,157,917 to Timothy P. Barber.

4. As for claims 15, 27, and 33, a method for electronic commerce by a merchant, comprising:
 - offering an item for purchase by a buyer on a page per fee basis at a predetermined price via a network link (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27);;
 - defining terms for advertising, in accordance with which an advertiser posts an advertisement for the item, the advertisement containing a reference to the network link (See Messer col. 5, ln. 4-33, and col. 8, ln. 44-68, and Barber col. 5, ln. 1-43);

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- receiving from the advertiser an order for supply of the item to the buyer responsive to invocation of the link in the advertisement by the buyer (See Messer abstract figure 1, 2, 6A, col. 5, ln. 4-33, and 6B, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27);;
- conveying the item, responsive to the order, via the advertiser to the buyer (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27); and
- receiving payment from the buyer for the item, while a predefined portion of the price is paid to the advertiser in consideration for posting the advertisement, in accordance with the terms of advertising (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27).

5. As for claims 16, 28, and 34, Messer and Barber disclose, all the limitations of claims 15, 27, and 33, further;

Both Messer and Barber clearly teach that the offering the item for purchase comprises offering the item on a Web page of a Web site maintained by the merchant and accessible via the Internet, and wherein conveying the order comprises granting the buyer access to the Web page (See Messer col. 4, ln. 25-68 and col. 5, ln. 1-33 and Barber col. 3, ln. 26, col. 4, ln. 1-48, and col. 5, ln. 1-68).

6. As for claims 20, Messer and Barber disclose, all the limitations of claims 16, further;

Messer clearly teaches that the defining the terms for advertising comprises defining terms according to which the advertisement is displayed on a Web site of the advertiser (See Messer col. 7, ln. 1-68, col. 8, ln. 1-68, and col. 9, ln. 1-63).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 17-19, 21-26, 29-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,740 to Stephen Dale Messer in view of U.S. Patent No. 6,157,917 to Timothy P. Barber.

8. As for claims 1, 24, and 30 a method for electronic advertising by an advertiser, comprising:

- posting an advertisement for an item offered to a buyer for purchase from a merchant on a page per fee basis at a predetermined price via a network link to a network address represented in the advertisement by an alias, which conceals the network address from the buyer (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27);
- receiving an invocation of the link from the buyer; responsive to the invocation, transmitting an order to the merchant for supply of the item to the buyer in exchange for payment of the price by the buyer (See Messer abstract figure 1, 2, 6A, col. 5, ln. 4-33, and 6B, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27);
- conveying the item, responsive to the order, from the merchant to the buyer (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27); and

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- receiving a predefined portion of the price paid by the buyer in consideration for posting the advertisement (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68, and Barber abstract, col. 1, ln. 43-68, and col. 2, ln. 1-42, col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27).

What Messer does not explicitly discuss is a network address represented in the advertisement by an alias, which conceals the network address from the buyer. However, Barber clearly teaches the method and system to hide a URL from the user and providing access to the desired location by utilizing an alias (See Barber col. 7, ln. 23-68, and col. 8, ln. 1-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated.

9. As for claims 2, 25, and 31 Messer and Barber disclose, all the limitations of claims 1, 24, and 30, further;

Both Messer and Barber clearly teach that the posting the advertisement comprises displaying the advertisement on a Web site maintained by the advertiser and accessible to the buyer via the Internet, and wherein receiving the invocation comprises receiving an indication that the buyer has selected the link (See Messer col. 5, ln. 4-33, and col. 8, ln. 44-68, and Barber col. 5, ln. 1-43).

10. As for claims 3, 17, 26, 29, 32 and 35 Messer and Barber disclose, all the limitations of claim 2, 16, 25, 28, 31, and 35 further;

Both Messer and Barber clearly teach that the transmitting the order comprises transmitting the order in exchange for a payment made from the buyer to the merchant (See Messer col. 9, ln. 1-55 and Barber col. 5, ln. 1-43). In addition, it is clear that Barber's system and method is proposing a "Micro Payment" system that is utilized to make transactions that are very small as well as it could be used for other types of transactions. Additionally, the fact the transaction involved is based on a micro payment or any other type of payment does effect any part of the systems operations.

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11. As for claims 4 and 18, Messer and Barber disclose, all the limitations of claims 3 and 17, further;

Both Messer and Barber clearly teach that the responsive to the payment, a billing server transfers a credit to the merchant, and wherein receiving the predefined portion of the price comprises receiving from the billing server a portion of the payment (See Messer col. 9, ln. 1-55 and Barber col. 5, ln. 1-43). In addition, it is clear that Barber's system and method is proposing a "Micro Payment" system that is utilized to make transactions that are very small as well as it could be used for other types of transactions. Additionally, the fact the transaction involved is based on a micro payment or any other type of payment does effect any part of the systems operations.

12. As for claims 5 and 19, Messer and Barber disclose, all the limitations of claims 3 and 17, further;

Both Messer and Barber clearly teach that receiving the predefined portion of the price comprises receiving from the merchant a portion of the payment (See Messer col. 9, ln. 1-55 and Barber col. 5, ln. 1-43). In addition, it is clear that Barber's system and method is proposing a "Micro Payment" system that is utilized to make transactions that are very small as well as it could be used for other types of transactions. Additionally, the fact the transaction involved is based on a micro payment or any other type of payment does effect any part of the systems operations.

13. As for claim 6, Messer and Barber disclose, all the limitations of claim 2, further;

What Messer is not clear or explicit on conveying the item comprises allowing the buyer to access one or more Web pages of the merchant (See Messer col. 4, ln. 47-59). However, Barber clearly teaches the method and system to allowing the buyer to access one or more Web pages of the merchant once the user has fulfilled the transaction obligation related to viewing that particular merchants offering (See Barber col. 5, ln. 1-43, col. 7, ln. 23-68, and col. 8, ln. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to direct a user to the destination web page after transaction has successfully completed and providing access to the final destination desired by the user.

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14. As for claim 7, Messer and Barber disclose, all the limitations of claim 1, further;

What Messer is not clear or explicit on is that alias assigned by the merchant to correspond to the item offered for purchase. However, Barber clearly teaches the method and system that merchant assigns an alias to correspond to the item offered for purchase (See Barber col. 7, In. 23-68, and col. 8, In. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to conceal the actual URL for preventing the user from directly accessing the destination page and achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated.

15. As for claims 8 and 22, Messer and Barber disclose, all the limitations of claims 7 and 21, further;

What Messer is not clear or explicit on is that sending the communication comprises passing the alias (Concealed URL) from the advertiser to the merchant (See Messer col. 4, In. 47-60 and col. 8, In. 4-68). However, Barber clearly teaches the method and system that sending the communication comprises passing the alias (Concealed URL) from the advertiser to the merchant (See Barber col. 7, In. 23-68, and col. 8, In. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to conceal the actual URL for preventing the user from directly accessing the destination page and achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated.

16. As for claim 9, Messer and Barber disclose, all the limitations of claim 8, further;

What Messer is not clear or explicit on is that passing the alias (Coded, embedded, or concealed URL) comprises passing the alias (Coded, embedded, or concealed URL) in a coded form (See Messer col. 4, In. 47-60). However, Barber clearly teaches the method and system that passing the alias (Coded, embedded, or concealed URL) is in a coded form (See Barber col. 7, In. 23-68, and

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col. 8, ln. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to conceal the actual URL for preventing the user from directly accessing the destination page and achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated.

17. As for claim 10, Messer and Barber disclose, all the limitations of claim 1, further;

What Messer is not clear or explicit on is that the alias is assigned by the merchant to correspond specifically to the advertiser, among a plurality of advertisers who post the advertisement. However, Barber clearly teaches the method and system that the alias is assigned by the merchant to correspond specifically to the advertiser, (See Barber col. 4, ln. 3-48, col. 7, ln. 23-68, and col. 8, ln. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to conceal the actual URL for preventing the user from directly accessing the destination page and achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated. In addition, merchants have to be able to identify the web page the user is coming from by the means of assigning identifying parameters to the concealed URLs for each advertising web site to be able to keep track of user's originating site for further compensation for the referral fees due to the advertising web site. Therefore, it would have been obvious to assign identifier parameters to the URLs.

18. As for claim 11, Messer and Barber disclose, all the limitations of claim 1, further;

Both Messer and Barber clearly teach that transmitting the order comprises sending a communication from the advertiser to the merchant including an identifying code issued to the advertiser by the merchant (See Messer col. 4, ln. 47-60 and Barber col. 4, ln. 3-48, col. 7, ln. 23-68, and col. 8, ln. 1-27).

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19. As for claim 12, Messer and Barber disclose, all the limitations of claim 1, further;

Both Messer and Barber clearly teach that transmitting the order comprises making a record of the order for use in verifying that the predefined portion of the price is paid to the advertiser by the merchant (See Messer col. 9, ln. 21-26 and Barber col. 5, ln. 1-68)

20. As for claim 13, Messer and Barber disclose, all the limitations of claim 1, further;

Messer clearly teaches posting the advertisement comprises posting the advertisement in accordance with advertising terms published by the merchant, and wherein receiving the predefined portion of the price comprises receiving the portion as specified by the advertising terms (See Messer col. 6, ln. 1-68, col. 7, ln. 1-68, col. 8, ln. 1-68, and col. 9, ln. 1-55).

21. As for claim 14, Messer and Barber disclose, all the limitations of claim 13, further;

Messer clearly teaches transmitting the order comprises submitting, along with the order, a coded reference to the advertising terms (See Messer col. 8, ln. 4-68).

22. As for claims 21, Messer and Barber disclose, all the limitations of claims 15, further;

Messer does not explicitly discuss is defining the terms for advertising comprises assigning an alias to serve as the reference to the network link in the advertisement, so as to conceal the network address from the buyer (See Messer abstract figure 1, 2, 6A and 6B, col. 5, ln. 4-33, and 7, col.3, ln. 1-68). However, Barber clearly teaches the method and system to hide a URL from the user and providing access to the desired location by utilizing an alias (See Barber col. 7, ln. 23-68, and col. 8, ln. 1-47).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated.

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23. As for claim 23, Messer and Barber disclose, all the limitations of claim 15, further;

What Messer is not clear or explicit on is that defining the terms for advertising comprises issuing an identifying code to the advertiser, and wherein receiving the order comprises receiving a message including the code. (See Messer col. 4, ln. 47-60). However, Barber clearly teaches the method and system that passing the alias (Coded, embedded, or concealed URL) is in a coded form (See Barber col. 7, ln. 23-68, and col. 8, ln. 1-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teachings to conceal the actual URL for preventing the user from directly accessing the destination page and achieve a more reliable and efficient processing system and method for preventing a user to circumvent the click through that is required for the advertising web site to be compensated. In addition, merchants have to be able to identify the web page the user is coming from by the means of assigning identifying parameters to the concealed URLs for each advertising web site to be able to keep track of user's originating site for further compensation for the referral fees due to the advertising web site. Therefore, it would have been obvious to assign identifier parameters to the URLs.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

David K. Gifford, U.S. Patent No. 6,195,649, Digital Active Advertising

Moni Naor, U.S. Patent No. 6,055,5080, Method For Secure Accounting and Auditing on A Communications Network.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

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or faxed to:

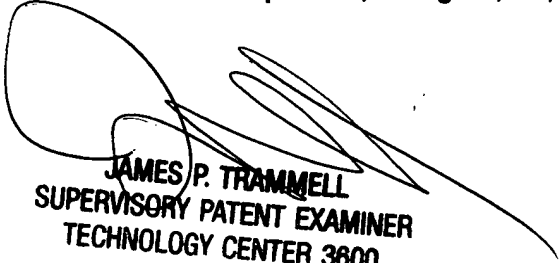
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Abdi/K
September 5, 2002



**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**